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BROOKS KUSHMAN P.C.
1000 TOWN CENTER
TWENTY-SECOND FLOOR
SOUTHFIELD, MI 48075

EXAMINER	
BORLINGHAUS, JASON M	
ART UNIT	**PAPER NUMBER**
3628	

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/037,827	SEIFERT ET AL.	
	Examiner	Art Unit	
	Jason M. Borlinghaus	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 May 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-38* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *1/3/2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

EA

DETAILED ACTION

Claim Objections

Claim 7 is objected to because of the following informalities: lack of antecedent basis. Claim 7 states, "the receive-transaction device is a personal computer". Examiner suggests that the applicant should change the claim language to "the receive-transaction initiating device is a personal computer" to bring the Claim language in line with the Claim language of Claims 6 and 8.

Claim 22 is objected to because of the following informalities: lack of antecedent basis and confusing claim language. Claim 22 states "receiving at the host computer system an identification code provided by the recipient, and generating the confirmation code by the host computer system based on the identification code, wherein the identification code is different than the first code." However, specification indicates that "...receive-agent enters the transaction identifying information into electronic terminal (see p. 8, lines 14 – 17) ...transmits the transaction identifying information to the host computer system (see p. 8, lines 14 – 17) ...(in response) host computer system may then generate, assign, or otherwise provide an identification code and a confirmation code (see p. 8, lines 27 – 30)." Examiner suggests that applicant changes claim language to be in line with disclosure provided by specification such as "receiving at the host computer system transaction identifying information provided by the recipient, and generating the identification code and confirmation code by the host computer system based on the transaction identifying information, wherein the identification code is different than the first code."

Correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2 – 4, 10, 11 – 13, 20, 23 – 27, 29, 33 – 34, 36 and 38 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4, 10, 12 – 13, 15, 17, 22, 23, 30, 40 and 54 of copending Application No. 09/975,171 (US PG Pub. 2003/0069856), herein referred to as PG Pub. '856.

Regarding Claims 1, 10 and 20, although the conflicting claims are not identical, they are not patentably distinct from each other because PG Pub. '856 claims:

- storing transaction data on a host computer system, wherein the transaction data includes a desired amount of money to be electronically transferred from a sender to a recipient. (see Claim 17 of PG Pub. '856);

- receiving transaction identifying information provided by the recipient/receiving at the host computer system transaction identifying information from a receive-transaction initiating terminal in communication with the host computer system, wherein the transaction identifying information is provided by the recipient. (see Claim 17 of PG Pub. '856);
- comparing the transaction identifying information with transaction data on the host computer system. (see Claim 17 of PG Pub. '856);
- providing a confirmation code (account code) and/or identification code, to be issued to the recipient, if the transaction identifying information matches the transaction data stored on the host computer system (see Claim 22 and Claim 23 of PG Pub. '856);
- storing the confirmation code (account code) and/or identification code on the host computer system. (see Claim 22 and Claim 23 of PG Pub. '856);
- receiving at the host computer system input corresponding to the confirmation code and/or identification code from a dispensing terminal in communication with the host computer system. (see Claim 40 of PG Pub. '856);
- comparing the input to the confirmation code and/or identification code stored on the host computer system (see Claim 40 of PG Pub. '856); and
- allowing funds, corresponding to at least a portion of the desired amount of money, to be dispensed by the dispensing terminal if the input matches

the confirmation code and/or identification code stored on the host computer system. (see Claim 40 of PG Pub. '856).

Regarding Claims 2 – 4 and 11 – 13, although the conflicting claims are not identical, they are not patentably distinct from each other because PG Pub. '856 claims a confirmation code (stored account code) and/or identification code (stored identification code). (See Claim 40 of PG Pub. '856). While PG Pub. '856 does not explicitly state that the confirmation code and/or the identification code includes a number, letter or symbol, it is well-known in the art that security codes, such as a PIN, an identification number and a computer password, can be composed of numbers, letters or symbols.

Regarding Claim 23, although the conflicting claims are not identical, they are not patentably distinct from each other because PG Pub. '856 claims loading payout funds corresponding to at least a portion of the desired amount of money in a payout account maintained on the host computer system, and allowing the payout account to go negative by an amount to cover a transaction fee associated with use of the dispensing terminal. (see Claim 54 of PG Pub. '856)

Regarding Claim 24, although the conflicting claims are not identical, they are not patentably distinct from each other because PG Pub. '856 claims loading payout funds corresponding to at least a portion of the desired amount of money in a payout account maintained on the host computer system, receiving at the host computer system a debit request from the dispensing terminal, automatically determining by the host computer system a transaction fee associated with use of the dispensing terminal

in response to receiving the debit request, and then loading an additional amount in the payout account to cover the transaction fee. (see Claims 12 – 13 of PG Pub. '856).

Regarding Claim 25, although the conflicting claims are not identical, they are not patentably distinct from each other because PG Pub. '856 claims the step of automatically determining the transaction fee includes assuming an even, whole dollar first portion of the debit request corresponds to a desired withdrawal amount for the recipient, and attributing a second portion of the debit request to the transaction fee. (see Claim 13 of PG Pub. '856).

Regarding Claim 26, although the conflicting claims are not identical, they are not patentably distinct from each other because PG Pub. '856 claims loading payout funds corresponding to at least a portion of the desired amount of money in a payout account maintained on the host computer system, and allowing the dispensing terminal to debit the payout account to cover a transaction fee associated with use of the dispensing terminal. (see Claim 10 of PG Pub. '856).

Regarding Claim 27, although the conflicting claims are not identical, they are not patentably distinct from each other because PG Pub. '856 claims the allowing step includes allowing funds, corresponding to a first portion of the desired amount of money, to be dispensed by the dispensing terminal if the input matches the confirmation code stored on the host computer system, and wherein the method further comprises receiving at the host computer system additional input corresponding to the confirmation code from an additional dispensing terminal in communication with the host computer system, comparing the additional input to the confirmation code stored on the host

computer system, and allowing additional funds, corresponding to a second portion of the desired amount of money, to be dispensed by the additional dispensing terminal if the additional input matches the confirmation code stored on the host computer system. (see Claim 4 and 15 of PG Pub. '856).

Regarding Claims 29, 36 and 38, although the conflicting claims are not identical, they are not patentably distinct from each other because PG Pub. '856 claims the step of receiving transaction identifying information includes receiving the transaction identifying information at the host computer system from an electronic terminal (a first terminal) that is different than the dispensing terminal (a second terminal). (see Claim 30 of PG Pub. '856).

Regarding Claims 33 and 34, although the conflicting claims are not identical, they are not patentably distinct from each other because PG Pub. '856 claims the allowing/authorizing step comprises allowing/authorizing the funds to be dispensed by the dispensing terminal to the recipient. (see Claim 40 of PG Pub. '856).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 21 – 22, 30 – 32 and 35 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 4, 10, 12 – 13, 15, 17, 22, 23, 30, 40 and 54 of copending Application No. 09/975,171, herein referred to as PG Pub. '856, in view of Walker (US Patent 5,650,604).

Regarding Claim 21 – 22 and 31, PG Pub. '856 claims:

- a method further comprising receiving at the host computer an identification code provided by the recipient. (see Claim 17 of PG Pub. '856).

PG Pub. '856 does not claim:

- a method wherein the transaction identifying information includes a first code provided by the sender to the recipient;
- a method further comprising generating the confirmation code by the host computer system based on the identification code, wherein the identification code is different than the first code; or
- a method wherein the confirmation code is not provided by or to the sender during the money transfer receive transaction.

Walker discloses:

- a method wherein the transaction identifying information includes a first code provided by the sender to the recipient. ("Transferor provides transferee with transferor identification number and other transaction information." – see 1220, figure 12A);
- a method further comprising receiving at the host computer system an identification code (transferor identification number) provided by the recipient, and generating the confirmation code (confirmation) by the host computer system based on the identification code, wherein the identification code is different than the first code. ("Transferor provides

transferee with transferor identification number and other transaction information." – see 1220, figure 12A). ("Central controller sends a confirmation to the transferee." – see 1275, figure 12B). It would be assumed that the confirmation code would be a different code than the identification code as there would be no value in repeating back to the recipient the same inputted code; and

- a method wherein the confirmation code (confirmation) is not provided by or to the sender during the money transfer receive transaction. ("Central controller sends a confirmation to the transferee." – see 1275, figure 12B).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified PG Pub. '856 by having the sender provide the recipient with the identification code that causes the host computer system to generate a confirmation code, as was done by Walker, as an additional security layer on the fund transfer process.

Regarding Claim 30 and 32, PG Pub. '856 claims a dispensing terminal. (see Claim 40 of PG Pub. '856).

PG Pub. '856 does not claim that:

- the dispensing terminal is an unattended teller machine.

Walker discloses that:

- the dispensing terminal is an unattended automatic teller machine. ("This credit can be used to offset other incurred charges on transferee's account

or can be withdrawn from the account as cash at an Automated Teller Machine (ATM)." – see paragraph 0057).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified PG Pub. '856 by allowing the recipient to receive the dispensed funds at an Automated Teller Machine, as was done by Walker, to provide the recipient a method to easily obtain the transferred funds.

This is a provisional obviousness-type double patenting rejection.

Claims 5, 14 and 28 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 4, 10, 12 – 13, 15, 17, 22, 23, 30, 40 and 54 of copending Application No. 09/975,171, herein referred to as PG Pub. '856, in view of Shore (US PG Pub. 2003/0149662).

Regarding Claim 5 and 14, PG Pub. '856 does not claim a method of wherein:

- the confirmation code and/or identification code includes an image.

Shore discloses a method of wherein:

- the confirmation code and/or identification code includes an image. ("The image verification would be an additional security measure that would work in conjunction with all the others." – see paragraph 0123).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified PG Pub. '856, by incorporating a variety of formats for the confirmation code and/or identification code, as was done by Shore, to ensure that the confirmation code and/or identification code could be communicated in a

versatile manner and for allowing further security measures for the funds transfer process.

Regarding Claim 28, although the conflicting claims are not identical, they are not patentably distinct from each other because PG Pub. '856 claims:

- storing the identification code on the host computer system. (see Claim 22 and Claim 23 of PG Pub. '856);
- receiving at the host computer system input corresponding to the confirmation code and/or identification code from a dispensing terminal in communication with the host computer system. (see Claim 40 of PG Pub. '856);
- comparing the additional input to the identification code stored on the host computer system (see Claim 40 of PG Pub. '856); and
- allowing funds, corresponding to at least a portion of the desired amount of money, to be dispensed by the dispensing terminal if the input matches the identification code stored on the host computer system. (see Claim 40 of PG Pub. '856).

PG Pub. '856 does not claim:

- receiving at the host computer an identification code from an electronic terminal that is different from the dispensing terminal, the identification code being an anatomical image of the recipient.

Shore discloses:

- receiving at the host computer an identification code from an electronic terminal that is different from the dispensing terminal, the identification code being an anatomical image (fingerprint and/or other biometric data) of the recipient. ("The image verification would be an additional security measure that would work in conjunction with all the others." – see paragraph 0123). ("In the exemplary embodiment, a user ID or and PIN and/or fingerprint (the phrase "fingerprint" is meant herein to include the "print" or other image of any finger, including a thumb) and/or other biometric data, would be required to access or transmit any data from the PDA device using the PDA software." – see paragraph 0018).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified PG Pub. '856, by incorporating a variety of formats for the identification code, as was done by Shore, to ensure that identification code could be communicated in a versatile manner and allowing for further security measures for the funds transfer process. While neither Seifert nor Shore explicitly state that anatomical image is entered via a first terminal, it is well-known in the art that anatomical image would need to be entered into the system prior to the recipient's use of the dispensing terminal.

This is a provisional obviousness-type double patenting rejection.

Claims 6 – 9 and 37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 4, 10,

12 – 13, 15, 17, 22, 23, 30, 40 and 54 of copending Application No. 09/975,171, herein referred to as PG Pub. '856, in view of Amann (US PG Pub 2002/0062285).

Regarding Claim 6 – 9, PG Pub. '856 does not claim:

- a method wherein the step of providing a confirmation code includes providing, by the host computer system, the confirmation code to a receive-transaction initiating device in communication with the host computer system;
- a method wherein the receive-transaction device is a personal computer;
- a method wherein the receive-transaction initiating device is a telephone; or
- a method wherein the step of providing a confirmation code includes providing, by a telephone operator, the confirmation code to the recipient.

Amann discloses:

- a method wherein the step of providing a confirmation code (PIN) includes providing, by the host computer system, the confirmation code to a receive-transaction initiating device in communication with the host computer system (P2P server). ("The P2P server is capable of transmitting the response to a payee computing device, which optionally includes the PIN code required to access the payment." – see paragraph 0014);
- a method wherein the receive-transaction device is a personal computer (payee computing device). ("The P2P server is capable of transmitting the

response to a payee computing device, which optionally includes the PIN code required to access the payment." – see paragraph 0014);

- a method wherein the receive-transaction initiating device is a telephone. ("Alternatively, the PIN code is transmitted to the payor computing device and communicated to the payee via any transmission method known to those skilled in the art, for example, via telephone or email." – see paragraph 0014); and
- a method of wherein the step of providing a confirmation code includes providing, by a telephone operator, the confirmation code to the recipient. (" Alternatively, the PIN code is transmitted to the payor computing device and communicated to the payee via any transmission method known to those skilled in the art, for example, via telephone or email." – see paragraph 0014).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified PG Pub. '856, by incorporating the ability to communicate the confirmation code and/or identification code to the recipient through a personal computer or through the telephone, as was done by Amann, to enhance ease of communication of the confirmation code and/or identification code to recipient.

Regarding Claim 37, PG Pub. '856 does not claim a method wherein:

- the identification number and the confirmation code are not provided by or to the sender during the money transfer receive transaction.

Amann discloses a method wherein:

- the identification number (PIN) and the confirmation code (notification) are not provided by or to the sender during the money transfer receive transaction. ("The P2P system delivers the notification and PIN code to the payee device, instructing the payee as to the location of the ATM instructed to dispense the currency for payment.' – see paragraph 0041).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified PG Pub. '856, by incorporating the ability to communicate the confirmation code and/or identification code to the recipient and not to the sender, as was done by Amann, to enhance security on the money transfer process.

This is a provisional obviousness-type double patenting rejection.

Claims 15 - 18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 4, 10, 12 – 13, 15, 17, 22, 23, 30, 40 and 54 of copending Application No. 09/975,171, herein referred to as PG Pub. '856, in view of Risafi (US Patent 6,473,500).

Regarding Claim 15, PG Pub. '856 claims:

- storing the identification code on the host computer system; (see Claim 22 and Claim 23 of PG Pub. '856);
- receiving at the host computer system input corresponding to the confirmation code and/or identification code from a dispensing terminal in communication with the host computer system. (see Claim 40 of PG Pub. '856);

- comparing the input to the confirmation code and/or identification code stored on the host computer system (see Claim 40 of PG Pub. '856); and
- allowing funds, corresponding to at least a portion of the desired amount of money, to be dispensed by the dispensing terminal if the input matches the confirmation code and/or identification code stored on the host computer system. (see Claim 40 of PG Pub. '856).

PG Pub. '856 does not claim:

- receiving an identification code established by the recipient.

Risafi discloses a method further comprising:

- receiving an identification code (PIN) established by the recipient. ("The user selects a PIN of his or her choice upon inserting the purchased card into an terminal or by accessing another designated device, such as a interactive voice response unit ("IVRU")." – see col. 3, line 65 – col. 4, line 1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified PG Pub. '856, by incorporating the ability for the recipient to select his own identification code, as was done by Risafi, to allow the identification code to be set to a code more easily remembered by the recipient.

Regarding Claims 16 – 18, although the conflicting claims are not identical, they are not patentably distinct from each other because PG Pub. '856 claims a confirmation code (stored account code) and/or identification code (stored identification code). (see Claim 40 of PG Pub. '856). While PG Pub. '856 does not explicitly state that the

confirmation code and/or the identification code includes a number, letter or symbol, it is well-known in the art that security codes, such as a PIN, an identification number and a computer password, can be composed of numbers, letters or symbols.

This is a provisional obviousness-type double patenting rejection.

Claim 19 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 4, 10, 12 – 13, 15, 17, 22, 23, 30, 40 and 54 of copending Application No. 09/975,171, herein referred to as PG Pub. '856, in view of Risafi and Shore.

Regarding Claim 19, PG Pub. '856 does not claim a method of wherein:

- the confirmation code and/or identification code includes an image.

Shore discloses a method of wherein:

- the confirmation code and/or identification code includes an image. ("The image verification would be an additional security measure that would work in conjunction with all the others." – see paragraph 0123).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified PG Pub. '856 and Risafi, by incorporating a variety of formats for the confirmation code and/or identification code, as was done by Shore, to ensure that the confirmation code and/or identification code could be communicated in a versatile manner and allowing further security for the funds transfer process.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 – 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marcous (US Patent 5,650,604) in view of Disclosed Prior Art (specification, pp. 1 – 3 and 12).

Regarding Claims 1, 6, 10, 15 and 20, Marcous discloses a method for performing a money transfer receive transaction involving a desired amount of money to be transferred from a sender to a recipient, the method comprising:

- storing transaction data on a host computer system (central terminal), wherein the transaction data includes a desired amount of money to be electronically transferred from a sender to a recipient. (see abstract);

- providing a confirmation code (security code/phone number) and/or identification code (PIN), to be issued to the recipient (via sender). (see col. 4, lines 16 – 22 and col. 8, lines 58 – 68);
- storing the confirmation code (security code/phone number) and/or identification code (PIN) on the host computer system (central terminal/pseudo-terminal). (see col. 7, lines 24 – 32);
- receiving at the host computer system input corresponding to the confirmation code (security code/phone number) and/or identification code (PIN) from a dispensing terminal (ATM) in communication (requesting authorization) with the host computer system (pseudo-terminal). (see col. 8, line 53 – col. 9, line 10);
- comparing the input to the confirmation code (security code/phone number) and/or identification code (PIN) stored on the host computer system (pseudo-terminal). (see col. 9, lines 7 – 10 and lines 24 – 30); and
- allowing funds (authorization approval), corresponding to at least a portion of the desired amount of money, to be dispensed by the dispensing terminal (ATM) if the input matches the confirmation code (security code/phone number) and/or identification code (PIN) stored on the host computer system (pseudo-terminal). (see col. 9, lines 40 – 57);

Marcous does not teach a method comprising:

- receiving at the host computer system transaction identifying information from a receive-transaction initiating terminal in communication with the

host computer system, wherein the transaction identifying information is provided by the recipient;

- comparing the transaction identifying information with transaction data on the host computer system;
- providing, by the host computer system, a confirmation code and/or identification code, to be issued to the recipient, if the transaction identifying information matches the transaction data stored on a host computer system; and
- receiving an identification code established by the recipient;

Disclosed Prior Art discloses a method comprising:

- receiving at the host computer system (database) transaction identifying information (money transfer control number or MTCN) from a receive-transaction initiating terminal (terminal) in communication with the host computer system (database), wherein the transaction identifying information is provided by the recipient ("...recipient may then enter the MTCN on a form, provided to an agent by the recipient. Next, the agent accesses the database using a terminal, and obtains a receive amount that corresponds to the MTCN." – see p. 2, lines 21 – 26);
- comparing the transaction identifying information (MTCN) with transaction data (stored data) on the host computer system (database). ("Next, the agent accesses the database using a terminal, and obtains a receive amount that corresponds to the MTCN." – see p. 2, lines 21 – 26 – It is

inherent that retrieving corresponding information requires comparing inputted information with stored data on the host computer system);

- providing, by the host computer system (database), information (receive amount), to be issued to the recipient, if the transaction identifying information (MTCN) matches the transaction data (stored data) on a host computer system (database). (see p. 2, lines 21 – 26); and
- entering input corresponding to two separate codes (two separate numbers) into a dispensing terminal (ATM). (see p. 12, lines 21 – 24).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Marcous by incorporating the ability to access the central computer, by either the recipient or an agent, to retrieve information regarding the transfer of funds from the sender to the recipient, as disclosed by Disclosed Prior Art. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Marcous by incorporating the ability of the recipient or agent to retrieve codes via this computer interaction, rather than having the sender relay all the information, as disclosed by Marcous, allowing the recipient to retrieve codes according to his schedule rather than the sender's schedule, and providing an additional layer of security to the transaction.

Furthermore, having a system user establish their own code, password or PIN is old and well known in the art of security systems and computer system designs. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Marcous and Disclosed Prior Art by incorporating the ability of having

the user establish their own identification code, as is old and well known, for eventual access to the transferred funds, allowing the user to establish an identification code which would be easier for the user to remember.

Regarding Claims 2 – 5, 11 – 14 and 16 – 19, Marcous discloses a method wherein the confirmation code (security code/phone number) and/or the identification code (PIN) includes:

- a number (phone number/PIN). (see col. 8, lines 58 – 68).

Neither Marcous nor Disclosed Prior teach a method wherein the confirmation code and/or the identification code includes:

- a letter;
- a symbol; and
- an image.

Utilizing letters, symbols and/or images in a code or password is old and well known in the art of security systems and cryptography. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Marcous and Disclosed Prior to allow for any combination of elements by which to compose the code that the inventor desired.

Regarding Claims 7 – 10, Marcous does not teach a method wherein:

- the receive-transaction device is a personal computer;
- the receive-transaction initiating device is a telephone; and
- the step of providing a confirmation code includes providing, by a telephone operator, the confirmation code to the recipient.

Disclosed Prior Art discloses a method wherein:

- the receive-transaction device is a personal computer (terminal). (see p. 2, lines 21 – 26).

Communicating information through a personal computer, a telephone and through a telephone operator is old and well known in the art of communication and information transmission. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Marcous and Disclosed Prior Art to transmit the information, as is communicated in Marcous and Disclosed Prior Art, through any means of communication that the inventor desired.

Regarding Claims 21 – 22, Marcous discloses a method further comprising:

- generating the confirmation code (system-generated PIN) by the computer system (terminal). (see col. 4, lines 16 – 22).

Marcous does not teach a method:

- wherein the transaction identifying information includes a first code provided by the sender to the recipient; and
- further comprising receiving at the host computer system an identification code provided by the recipient, and generating the confirmation code by the host computer system based on the identification code, wherein the identification code is different than the first code.

Disclosed Prior Art discloses a method:

- wherein the transaction identifying information (MTCN) includes a first code (MTCN) provided by the sender to the recipient. (see p. 2, lines 22 – 25); and
- further comprising receiving at the host computer system (database) an identification code (MTCN) provided by the recipient. (see p. 2, lines 22 – 25).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Marcous by incorporating the retrieval of information from the host computer system, as disclosed by Disclosed Prior Art, to the generation and provision of a code, as disclosed by Marcous, allowing the recipient to retrieve codes for eventual access to the transferred funds according to his schedule rather than the sender's schedule.

Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Marcous and Disclosed Prior Art so that the outputted code would be different from the inputted code, as having the inputted code being equal to the outputted code would have no value, making the communication with the host computer system meaningless. However, providing an outputted code different from the inputted code would have value by providing an additional security value, due to its provision of another security code for inputting into the dispensing terminal.

Regarding Claims 23 – 27, Marcous discloses a method:

- further comprising loading payout funds (principal monies) corresponding to at least a portion of the desired amount of money in a payout account (holding account) maintained on the host computer system (pseudo-terminal), and allowing the payout account to be credited by an amount to cover a transaction fee (convenience fee) associated with use of the dispensing terminal (pieces of the system responsible for carrying out the overall transfer transaction). (see p. 6, line 64 – p. 7, line 4); and
- receiving at the host computer system (pseudo-terminal) a debit request from the dispensing terminal. (see p. 9, line 1 – 4);
- loading (crediting) an additional amount (convenience fee) in the payout account (holding account) to cover the transaction fee (convenience fee). (see p. 6, line 67 – p. 7, line 7);
- further comprising loading payout funds (principal monies) corresponding to at least a portion of the desired amount of money in a payout account (holding account) maintained on the host computer system (pseudo-terminal), and allowing the dispensing terminal to debit the payout account (holding account) to cover a transaction fee (convenience fee) associated with use of the dispensing terminal (pieces of the system responsible for carrying out the overall transfer transaction). (see p. 6, line 64 – p. 7, line 4);
- wherein the allowing step (authorization approval) includes allowing funds, corresponding to a first portion of the desired amount of money, to be

dispensed by the dispensing terminal if the input matches the confirmation code (security code/phone number) stored on the host computer system (pseudo-terminal) (see col. 9, lines 40 – 57);

- and wherein dispensing terminals have dispensing limits. (see col. 9, line 58 – col. 10, line 6).

Marcous does not teach a method:

- further comprising loading payout funds corresponding to at least a portion of the desired amount of money in a payout account maintained on the host computer system, and allowing the payout account to go negative by an amount to cover a transaction fee associated with use of the dispensing terminal;
- further comprising loading payout funds corresponding to at least a portion of the desired amount of money in a payout account maintained on the host computer system, receiving at the host computer system a debit request from the dispensing terminal, automatically determining by the host computer system a transaction fee associated with use of the dispensing terminal in response to receiving the debit request, and then loading an additional amount in the payout account to cover the transaction fee;
- wherein the step of automatically determining the transaction fee includes assuming an even, whole dollar first portion of the debit request

corresponds to a desired withdrawal amount for the recipient, and attributing a second portion of the debit request to the transaction fee;

- wherein the allowing step includes allowing funds, corresponding to a first portion of the desired amount of money, to be dispensed by the dispensing terminal if the input matches the confirmation code stored on the host computer system, and wherein the method further comprises receiving at the host computer system additional input corresponding to the confirmation code from an additional dispensing terminal in communication with the host computer system, comparing the additional input to the confirmation code stored on the host computer system, and allowing additional funds, corresponding to a second portion of the desired amount of money, to be dispensed by the additional dispensing terminal if the additional input matches the confirmation code stored on the host computer system.

Disclosed Prior Art discloses:

- wherein the allowing (authorization) step includes allowing (authorizing) funds, corresponding to a first portion of the desired amount of money, to be dispensed by the dispensing agent if the input (MTCN) matches the confirmation code (MTCN) stored on the host computer system (database). (see p. 2, lines 21 – 26); and
- wherein the method further comprises allowing additional funds (additional checks), corresponding to a second portion of the desired amount of

money (funds in excess of payout limit), to be dispensed (encashed) by the additional dispensing location (elsewhere). (see p. 3, lines 5 – 10).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Marcous by incorporating the ability for the payout account to go negative to cover the transaction fee of the dispensing terminal, as Marcous discloses the ability of the payout account to be credited with additional funds to cover the transaction fee of the dispensing terminal, which has the same result, to relieve the recipient of transferred funds with the expenses and fees involved in the transfer transaction.

Additionally, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Marcous to automatically determine the transaction fee, as Marcous discloses determining the amount to be credited to the payout account to cover the transaction fee, since it has been held that broadly providing a mechanical or automatic means to replace manual activity that accomplishes the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

Additionally, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Marcous to determine the transaction fee in response to receiving a debit request, as no dispensing terminal transaction fee would be incurred until the debit request was entered into the dispensing terminal.

Additionally, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Marcous to allow for any assumptions

regarding which portion of the debit request/payout account is allocated for the transferred funds and/or transaction fee that the inventor desired.

Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Marcous and Disclosed Prior Art to allow for multiple iterations of the above process, by allowing the recipient to retrieve a second portion of the transferred funds at a second location at a second time, undergoing the same security procedure utilized initially, as both Marcous and Disclosed Prior Art acknowledge dispensing limits on the dispensing of transferred funds.

Regarding Claim 28, Claim 28 recites similar limitations to Claims 1, 6, 7, 10, 14, 15, 18 and 20, in combination, and is therefore rejected using the same art and rationale as applied in the rejection of Claims 1, 6, 7, 10, 14, 15, 18 and 20,. Claim 28 differs from Claims 1, 6, 7, 10, 14, 15, 18 and 20, due to its Claim to:

- receiving at the host computer system an identification code from an electronic terminal that is different from the dispensing terminal, the identification code being an anatomical image of the recipient.

Marcous discloses a method further comprising:

- storing the an identification code (PIN) on the host computer system (central terminal/pseudo-terminal). (see col. 7, lines 24 – 32).

Marcous does not teach a method further comprising:

- receiving at the host computer system an identification code from an electronic terminal that is different from the dispensing terminal, the identification code being an anatomical image of the recipient.

Disclosed Prior Art discloses a method further comprising:

- receiving at the host computer system (database) recipient information from an electronic terminal (computer/point of sale terminal) that is different from the dispensing location (see p. 1, lines 17 – 23).

Utilizing a biometric or anatomical image for security purposes is old and well known in the art of security systems and cryptography. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Marcous by incorporating an anatomical image as the identification code, as disclosed by Marcous, to enable the system to utilize a security code which could not be easily intercepted nor fraudulently obtained.

Additionally, it would have been obvious to one with ordinary skill in the art at the time the invention was made to have modified Marcous and Disclosed Prior Art to have allowed the submission of the anatomical image to the host computer system from an electronic terminal different from the dispensing terminal, such as disclosed by Disclosed Prior Art in regards to submission of recipient information, as submission of the anatomical image to the host computer system from the dispensing terminal provides no security benefits whatsoever unless the anatomical image was already on file at the host computer system, being entered through other means.

Regarding Claims 29 – 38, Marcous discloses a method:

- wherein the allowing/authorizing step (authorization approval) comprises allowing/authorizing (authorizing) the funds to be dispensed by the dispensing terminal (ATM) to the recipient. (see col. 9, lines 40 – 57);
- wherein the dispensing terminal is an unattended automated teller machine. (see 230, figure 2);
- identification number (PIN) and/or confirmation code (security code/phone number) are provided by or to the sender during the money transfer receive transaction. (see col. 4, lines 16 – 22 and col. 8, lines 58 – 68); and
- allowing funds (authorization approval), corresponding to at least a portion of the desired amount of money, to be dispensed by the dispensing terminal (ATM) if the input matches the confirmation code (security code/phone number) and/or identification code (PIN) stored on the host computer system (pseudo-terminal). (see col. 9, lines 40 – 57).

Marcous does not teach a method:

- wherein the step of receiving transaction identifying information includes receiving the transaction identifying information at the host computer system from an electronic terminal that is different than the dispensing terminal;

- wherein receiving transaction identifying information provided by the recipient comprises receiving the transaction identifying information from a receive-transaction initiating terminal that is different than the dispensing terminal;
- wherein the transaction data further includes a first code provided by the sender to the recipient, the first code being different than the confirmation code, and wherein the transaction identifying information includes the first code;
- identification number and/or confirmation code are not provided by or to the sender during the money transfer receive transaction; and
- wherein the receive-transaction initiating terminal is different than the dispensing terminal.

Disclosed Prior Art discloses a method:

- wherein the step of receiving transaction identifying information includes receiving the transaction identifying information at the host computer system (database) from an electronic terminal (terminal). (see p. 2, lines 21 – 26);
- wherein receiving transaction identifying information (MTCN) provided by the recipient comprises receiving the transaction identifying information (MTCN) from a receive-transaction initiating terminal (terminal). (see p. 2, lines 21 – 26);

- wherein there is a receive-transaction initiating terminal (terminal). (see p. 2, lines 21 – 26); and
- wherein the transaction data (stored data) further includes a first code (MTCN) provided by the sender to the recipient, and wherein the transaction identifying information (MTCN) includes the first code (MTCN). (see p. 2, lines 21 – 26);

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Marcous by incorporating the ability to access the host computer, by either the recipient or an agent, to retrieve information regarding the transfer of funds from the sender to the recipient, as disclosed by Disclosed Prior Art. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Marcous by incorporating the ability of the recipient or agent to retrieve codes via this computer interaction, rather than having the sender relay all the information, as disclosed by Marcous, allowing the recipient to retrieve codes according to his schedule rather than the sender's schedule, and providing an additional layer of security to the transaction.

Additionally, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Marcous by incorporating the ability to access the host computer for retrieval of information such as codes for access to the transferred funds, as utilized by Marcous, at a terminal, as disclosed by Disclosed Prior Art, different from the dispensing terminal for security purposes, as obtaining the codes

for access to the money at the same terminal through which the funds would be dispensed lacks any security benefits.

Additionally, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Marcous and Disclosed Prior Art so that the outputted code (second code) would be different from the inputted code (first code), as having the inputted code being equal to the outputted code would have no value, making the communication with the host computer system meaningless. However, providing an outputted code different from the inputted code would have value by providing an additional security value, due to its provision of another security code for inputting into the dispensing terminal.

Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Marcous and Disclosed Prior Art to incorporate the ability to provide the recipient with codes for access to the transferred funds, as disclosed by Marcous, directly, such as through the terminal, as disclosed by Disclosed Prior Art, eliminating the provision of such codes to the sender, reducing the distribution of the security information to a minimal number of people, and reducing the possibility of interception of such information and fraudulent interception of the transferred funds.

Response to Arguments

Applicant's arguments filed on 5/16/2005 have been fully considered but they are not persuasive.

Regarding the double patenting rejection, the applicant argues that "no unjustified or improper timewise extension of the right to exclude exists" and therefore the rejection based upon double patenting should be rescinded. (Applicants' Arguments, p. 10). However, a terminal disclaimer exists for two reasons, only the first reason being to prevent an unjustified time extension. A terminal disclaimer also exists to prevent separation of otherwise intertwined patents between multiple parties, thereby creating an environment prone to infringement. ("This requirement serves to avoid the potential for harassment of an accused infringer by multiple parties with patents covering the same patentable invention.") See MPEP 804.2 (VI).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Borlinghaus whose telephone number is (571) 272-6924. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on (571) 272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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HYUNG SOUGH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600